

Remarks

In view of the following amendments and remarks, favorable reconsideration of the outstanding office action is respectfully requested. Claims 1 – 21 remain in this application. Claims 1, 7, 8, 12, 14, and 15 have been amended. Claims 6 and 11 have been canceled. Claims 16 – 18 have been withdrawn from consideration, without prejudice.

1. Allowed Claims/Subject Matter

Applicant notes with appreciation that the Examiner has indicated the subject matter of claims 10, 13, and 15 are patentable, and would be allowable if rewritten in independent form.

2. § 112 Rejections

The Examiner has rejected claims 8 – 15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. In particular, claim 8, claim 14, and claim 15 each included terms that did not comply with the accepted rules regarding proper antecedent basis in the claims. In response, the applicants have amended claims 8, 14, and 15.

3. § 102 Rejections

The Examiner has rejected claims 1 – 5 and 19 - 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,545,216 to Bell et al. (hereinafter Bell).

Bell is directed to a mounting assembly that includes a junction box having a top wall and a downwardly extending side wall defining a cavity therein. A fixture support is provided on the junction box that has a first use position and a second use position, and the fixture support is movable from the first use position to the second use position. Mounting assembly may include a junction box with a fixture support attached to the junction box, and a first fixture fastener provided on a fixture support. The first fixture fastener may be sized for securing a first type of fastener. A second fixture fastener sized for securing a second size of fastener may be provided on the fixture support. The fixture support is moveable between a use position for the first fixture fastener and a non-use position for the first fixture fastener.

The first and second fixture support may be movable, such as by rotation relative to a part of the junction box.

According to **MPEP 2131**, “to anticipate a claim, the reference must teach every element of the claim.” A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicant respectfully points out that the Examiner did not make a *prima facie* case of anticipation relative to original claims 1 – 5 and 19 – 21 because the Examiner did not shown where Bell discloses *a mounting assembly* as recited in original claim 1. The fact that the Examiner also uses Bell in a rejection under 35 U.S.C. § 103(a) illustrates that Bell does not provide the necessary and sufficient disclosure to support a rejection under 35 U.S.C. § 102(b).

With regard to the dependent claims, the Examiner’s asserts that claim 2 is “purely functional.” The applicant points out that claim 2 is not functional at all – is recites that *the electrical box is configured to be coverable by a fixture base cover*. In other words, the electrical box is configured in a particular shape that accommodates a cover. The Examiner does not provide any reasons why claims 3 – 5 and 19 – 21 are rejected under the Bell reference.

Accordingly, the applicant respectfully requests that the rejection of claims 1 – 5 and 19 – 21 under 35 U.S.C. § 102(b) be withdrawn.

4. § 103 Rejections

The Examiner has rejected claims 1 – 9, 11, and 19 – 21 under 35 U.S.C. § 103 as being unpatentable for obviousness over U.S. Patent No. 2,380,793 to Rugg in view of Bell.

The applicant has amended the mounting assembly in claim 1 to further recite *a plurality of tab members configured to be inserted into the plurality of slots such that the plurality of tab members and the base member form a channel, the channel being configured to receive the structural member therein, whereby the electrical box is coupled to the structural support member*. For sake of completeness, the applicant notes that claim 6 and claim 11 are canceled to eliminate any redundancy. Claims 7, 8, and 12 have been amended in light of the canceled claims.

According to the **MPEP 2143**, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A. The prior art references do not teach or suggest all the claim limitations

As noted above, the prior art references must teach or suggest all the claim limitations to establish a *prima facie* case of obviousness. Amended claim 1 recites a ceiling fixture support assembly that comprises a mounting assembly that includes “*a plurality of tab members configured to be inserted into the plurality of slots such that the plurality of tab members and the base member form a channel, the channel being configured to receive the structural member therein, whereby the electrical box is coupled to the structural support member.*” Neither Bell nor Rugg, whether taken alone or in combination, teach or suggest a ceiling fixture support assembly having the mounting assembly recited in amended claim 1.

B. There is no proper motivation to combine references

There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In this case, the prior art does not suggest the desirability of the combination. In fact, the secondary reference changes the principle of operation of the primary reference. It is well settled that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In this case, the inventor of the primary reference, Edward Rugg, explicitly states "A box as shown in the drawing is standardized in the wiring industry...My invention has to do with a means for mounting such a standardized box *on a bar hanger*." See col. 1, lines 40 – 41. Bell, on the other hand, discloses holes 26 and apertures 28, which are used to accommodate screws and/or nails for directly "attaching the electrical box to studs, braces, or joists." See col. 3, lines 42 – 53.

Accordingly, the applicant respectfully asserts that claims 1 – 21 are allowable under 35 U.S.C. § 103.

5. Conclusion

Based upon the amendments, remarks, and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1 – 5, 7 – 10, and 12 – 21 and a prompt Notice of Allowance thereon.

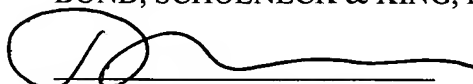
Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-1546.

Please direct any questions or comments to Daniel P. Malley at (607) 330-4010.

Respectfully submitted,

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